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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,240	01/08/2004	William Gerrie	86794.000012	6684

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT	PAPER NUMBER
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3636

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/753,240	Applicant(s) GERRIE ET AL.	
	Examiner Tamara L. Graysay	Art Unit 3636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) 9-13, 17-19 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-16, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>(2 pages)</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species:
 - A. FIGS. 1-5
 - B. FIGS. 6-9

The species are independent or distinct because of the following:

The species are related under the disclosure. The species are both (1) species under a claimed genus and (2) related. Therefore, the question of restriction must be determined by both (i) the practice applicable to election of species and (ii) the practice applicable to other types of restrictions. MPEP § 806.04(b).

(i) The Practice Applicable to Election of Species:

(A) The inventions as claimed do not overlap in scope, i.e., are mutually exclusive.

Claims are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first.

In the present application claim 3 recites the frame including a housing and the canopy in the stowed position at least partly disposed in a roll in the housing which limitations are only for A, and claim 9 recites the canopy in the stowed position lies within the footprint of the golf cart roof which limitations are only for B.

Therefore, the claimed species are mutually exclusive.

(B) The inventions as claimed are not obvious variants.

In the present application, the disclosure at [0046] points out that species B illustrates another embodiment where the housing is not used, but the device is modified so that the canopy is stored in a flat configuration under the roof of a golf cart. The use of a housing in which the canopy is rolled is not an obvious variant of the canopy being stored flat and under the roof of a golf cart.

Therefore, the claimed species are not obvious variants.

(C) The inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, or effect.

In the present application, species A and B, as claimed, are not capable of use together.

(ii) The Practice Applicable to Other Types of Restrictions:

In order to establish reasons for insisting upon restriction, an explanation must be made of why there would be a serious burden on the examiner if restriction were not required. A serious burden may be shown by one or more of (1) separate classification, (2) separate status in the art when classifiable together, and (3) different field of search.

In the present application, the claimed features of the housing and the bead edged canopy (species A) and the claimed features of the axle, pulley, and cord (species B) required different fields of search as evidenced by their structural differences.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 6, 14 and 20 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. During a telephone conversation with Mr. Brian Shaw, Reg. No. 33782, on 02 March 2006 a provisional election was made with traverse to prosecute the invention of species A. FIGS. 1-5, claims 1-8, 14-16, 20, 21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-13, 17-19, 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

4. The drawings are objected to because of the following:
- a. They fail to comply with 37 CFR 1.84(l) because every line (ALL FIGS) is not sufficiently dense and dark, and uniformly thick and well-defined.
 - b. They fail to comply with 37 CFR 1.84(p)(1) because the reference characters are not plain and legible.
 - c. They fail to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description: "58" [0043].
 - d. They fail to comply with 37 CFR 1.84(u)(2) because the view numbers are not larger than the numbers used for reference characters.
 - e. The enlarged view should be indicated on the view from which the enlarged view is taken. Specifically, FIG. 2 should include a circle designated with the number 2A and FIG. 6 should include a circle designated with the number 6A. Applicant's manner of indicating the enlarged view improperly connects the detailed view with the other figure via an arrowed line.
 - f. Reference characters 152 (two occurrences) at the center and right half of FIG. 9 should be 150 because the lead line is directed to the roof support columns, not the roof.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The abstract of the disclosure is objected to because of the following:

At line 5, “of” should be or to correct a typographical error.

Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities:

a. There is no brief description of FIG. 2A.

b. [0021]: [Figure 2] should be Figure 1 because the section line is taken in FIG. 1, not FIG. 2.

c. There is no brief description of FIG. 6A.

d. [0031]: Section line 8-8 is mentioned with regard to FIG. 6; however, there is no section line 8-8 in FIG. 6.

e. [0013]: The sentence contains a grammatical error.

f. [0048]: axle is misspelled.

g. [0049]: 133 should be inserted after leading edge.

Appropriate correction is required.

Claim Objections

7. Claims 1-8, 14-16, 20-21 are objected to because of the following informalities:
- a. Claim 1: The preamble is directed to the cover alone. However the body of the claim infers positive recitation of the golf cart and/or golf bag. The claim has been treated as a subcombination. For example, “extending in an aft direction from a rear roof line of the golf cart” which limitation has been treated as a functional limitation only. That is to say *adapted to extend* in an aft direction. Further, “protectively overlying the golf bag” which limitation has been treated as a functional limitation only. That is to say *adapted to protectively overlie* the golf bag.
 - b. Claims 2 and 7-13: The preamble of each claim (retractable rain *protector*) is not commensurate with the preamble of claim 1 (retractable rain *cover*).
 - c. Claims 2, 14-16: The body of each claim positively recites the golf bag, however the preamble is limited to the rain cover alone. The claim has been treated as a subcombination. See comments regarding claim 1.
 - d. Claims 20-21: The preamble recites the cover in combination with the golf cart however, the body of the claim positively recites the golf bag (e.g., extending ... over a golf bag carried at the rear of the golf cart). The claims have been treated as drawn to the golf cart and cover, not including the golf clubs. See comments regarding claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Dolan (US 6481780).

a. Claim 1: Dolan discloses a rigid frame (255, 270; FIG. 2A) attachable to a golf cart (200) the frame having an aft end portion (in the area of corners 262, 267) sized to encompass at least an upper end of a golf bag (237) carried on the cart (200) and the aft end portion extending from the rear roof line (uppermost end of frame member 252, 270) to a position below the upper end of the golf bag (FIG. 2A); and, a flexible canopy (260) carried by the frame and movable relative to the frame (material 260 may be detached from the frame and rolled toward the rear frame 240; 4:57-62) between a stowed position (rolled toward the rear frame) and deployed position (as depicted in FIG. 2A), the canopy disposed along the aft end (FIG. 2A) and adapted to protectively overlies the golf bag.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 14, 15, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (US-6481780) in view of Chapman (US-5146967).

a. Claim 2: Chapman teaches a cover having at least one closable opening (access orifice 4) adapted to align with an upper end of a golf bag when the canopy is deployed (FIG. 1) to allow access to the golf clubs when the canopy is in the deployed position and without removing the canopy.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the canopy of Dolan to include at least one closable opening such as suggested by Chapman, in order to access the golf clubs when the canopy is in a deployed position.

b. Claim 14, 15: Dolan discloses a rigid frame (255, 270; FIG. 2A) attachable to a golf cart (200) the frame having an aft end portion (in the area of corners 262, 267) sized to encompass at least an upper end of a golf bag (237) carried on the cart (200) and the aft end portion extending from the rear roof line (uppermost end of frame member 252, 270) to a position below the upper end of the golf bag (FIG. 2A); and, a flexible canopy (260) carried by the frame and movable relative to the frame (material 260 may be

detached from the frame and rolled toward the rear frame 240; 4:57-62) between a stowed position (rolled toward the rear frame) and deployed position (as depicted in FIG. 2A), the canopy disposed along the aft end (FIG. 2A) and adapted to protectively overlie the golf bag.

Dolan lacks the closable opening adapted to align with the golf bag when the canopy is deployed.

Chapman teaches a cover having at least one closable opening (access orifice 4) adapted to align with an upper end of a golf bag when the canopy is deployed (FIG. 1) to allow access to the golf clubs when the canopy is in the deployed position and without removing the canopy.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the canopy of Dolan to include at least one closable opening such as suggested by Chapman, in order to access the golf clubs when the canopy is in a deployed position.

c. Claim 20: Dolan discloses a rigid frame (255, 270; FIG. 2A) connected to a golf cart (200) at the rear thereof, the frame having an aft end portion (in the area of corners 262, 267) sized to encompass at least an upper end of a golf bag (237) carried on the cart (200) and the aft end portion extending from the rear roof line (uppermost end of frame member 252, 270) to a position below the upper end of the golf bag (FIG. 2A); and, a flexible canopy (260) carried by the frame and movable relative to the frame (material 260 may be detached from the frame and rolled toward the rear frame 240; 4:57-62)

between a stowed position (rolled toward the rear frame) and deployed position (as depicted in FIG. 2A), the canopy disposed along the aft end (FIG. 2A) and adapted to protectively overlie the golf bag.

Dolan lacks the closable opening adapted to align with the golf bag when the canopy is deployed.

Chapman teaches a cover having at least one closable opening (access orifice 4) adapted to align with an upper end of a golf bag when the canopy is deployed (FIG. 1) to allow access to the golf clubs when the canopy is in the deployed position and without removing the canopy.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the canopy of Dolan to include at least one closable opening such as suggested by Chapman, in order to access the golf clubs when the canopy is in a deployed position.

10. Claims 3, 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (US-6481780) in view of Veilleux (US-3146824).

a. Claims 3 and 4: The Dolan canopy is in the field of framed covers. Veilleux, also in the field of framed covers, teaches a canopy (10) and a housing (4). The canopy, when stowed, is at least partly disposed in a roll in the housing (e.g., FIG. 2). The canopy is biased toward the stowed position (3:39-47). Such an arrangement provides a compact storage area for the canopy when stowed and provides an easy deployment of the canopy from the roll within the housing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the frame of Dolan to include a housing, such as suggested by Veilleux, in order to provide a compact storage area for the canopy when stowed and provide an easy deployment of the canopy from the roll within the housing.

b. Claim 5: Further, Veilleux suggests using a catch (26) on a frame (in the case of Veilleux, the frame is the vehicle body 30) and a rod (14) attached to the leading end of the canopy (10), the catch and rod are engaged when the canopy is deployed to prevent movement of the canopy toward a stowed position (2:51-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the frame and canopy of the Dolan and Veilleux combination to include a catch on the frame and rod on the canopy, in order to prevent movement of the biased canopy toward a stowed position.

11. Claims 6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (US-6481780) in view of Dean (US-2520625).

a. Claim 6: Dolan discloses a frame having a horizontal piece (255) and a piece (252) angled relative to the horizontal piece adapted to extend from an elevation below the upper end of the golf bag upwardly and forward (FIG. 2A). The Dolan structure depicted in FIG. 2A lacks an upright piece because the horizontal piece is adapted to attach to the seat back rather than the vertical roof support and the angled piece is adapted to attach to the roof of the golf cart (e.g., 4:39-47). Dolan however, suggests that the frame is beneficial because it is adapted to be mounted on new or existing carts without intruding other features of the golf cart or equipment thereon. The depiction of the canopy in FIG. 2B shows a larger storage area having a “curved” piece (the vertical portion of 252 at the aft end of the frame and the upper horizontal portion of the frame 270). Dolan lacks an upright piece adapted to be connected to the roof support column.

Dean teaches a framed cover that includes spaced side members formed by rigid structural members including an upright piece (6, 8) attachable to a column (e.g., window frame 10). The upright piece inherently provides stability to the frame when it is mounted on a surface. Dean further comprises a horizontal piece (2, 4) extending in an aft direction; and a curved piece (12, 14) connecting the upright piece and the aft end of the horizontal member. The curved piece in Dean provides for more storage area beneath the frame and canopy.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dolan to include an upright piece that is adapted to be

mounted to the roof vertical support, such as suggested by the vertical piece in Dean, in order to provide a more stable connection than the four point connection of Dolan. Such an arrangement of adapting the Dolan frame to be mountable on the vertical roof support columns would avoid the unstable movement of the upper roof attachment points relative to the seat back attachment points caused by persons repeatedly embarking and disembarking the golf cart seat.

b. Claim 7: A change in shape is generally recognized as being within the level of ordinary skill in the art. The use of a curved upright piece presents no novel or unexpected result over the straight upright used in the combination of references. Use of such a connection in lieu of those used in the combination of references solves no stated problem and would have been an obvious matter of design choice within the skill of the art. *In re Launder*, 42 CCPA 886, 222 F.2d 371, 105 USPQ 446 (1955); *Flour City Architectural Metals v. Alpana Aluminum Products, Inc.*, 454 F. 2d 98, 172 USPQ 341 (8th Cir. 1972); *National Connector Corp. v. Malco Manufacturing Co.*, 392 F.2d 766, 157 USPQ 401 (8th Cir.) cert. denied, 393 U.S. 923, 159 USPQ 799 (1968).

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12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (US-6481780) and Dean (US-2520625) as applied to claim 7 above, and further in view of Chigusa (US-5176194).

Claim 8: In the combination, Dean includes a channel on the curved piece (created by flanges 14'). The Dolan and Dean combination lacks a bead on the canopy disposed in the channel. Chigusa teaches a bead (depicted in FIG. 2 at the edge of the canopy disposed in the channel). The bead is disposed in the channel for smoothly guiding the canopy along the channel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the canopy of the Dolan and Dean combination to include a bead at the edge of the canopy, such as suggested by the Chigusa bead, in order to smoothly guide the canopy along the channel.

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13. Claims 16, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (US-6481780) and Chapman (US-5146967) as applied to claims 15 and 20, respectively, above, and further in view of Veilleux (US-3146824).

a. Claim 16: The Dolan canopy, as modified by Chapman, is in the field of framed covers. Veilleux, also in the field of framed covers, teaches a canopy (10) and a housing (4). The canopy, when stowed, is at least partly disposed in a roll in the housing (e.g., FIG. 2). The canopy is biased toward the stowed position (3:39-47). Such an arrangement provides a compact storage area for the canopy when stowed and provides an easy deployment of the canopy from the roll within the housing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the frame of Dolan and Chapman to include a housing, such as suggested by Veilleux, in order to provide a compact storage area for the canopy when stowed and provide an easy deployment of the canopy from the roll within the housing.

b. Claim 21: The Dolan canopy, as modified by Chapman, is in the field of framed covers. Veilleux, also in the field of framed covers, teaches a canopy (10) and a housing (4). The canopy, when stowed, is at least partly disposed in a roll in the housing (e.g., FIG. 2). The canopy is biased toward the stowed position (3:39-47). Such an arrangement provides a compact storage area for the canopy when stowed and provides an easy deployment of the canopy from the roll within the housing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the frame of Dolan and Chapman to include a housing, such as suggested by Veilleux, in order to provide a compact storage area for the canopy when stowed and provide an easy deployment of the canopy from the roll within the housing.

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Conclusion

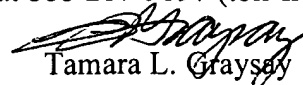
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Hughes (US-6068325) teaches a golf club protector at the rear of a golf cart.
- Adams (US-773618) teaches a retractable cover independent from the support frame at the rear of a vehicle.
- Campbell (US-473292) teaches a retractable vehicle cover having an arched support frame.
- Dewstow (US-1199766) teaches a retractable vehicle cover independent from the support frame.
- Tapia (US-6725807) teaches a vehicle cover independent from a support.
- Smith (US-5123474) teaches a bead at the edge of a retractable member (FIG. 13).
- Carroll (US-5259656) teaches a golf cart enclosure having a closable opening (12) to access golf clubs.
- Gunn (US-4544195) teaches a vehicle canopy having closable openings (22) therein covered by a flap (26).
- Henning (US-6474719) teaches a canopy having a pull rod (370) and catch (374) to retain the canopy in a deployed position.
- Peta (US-6227217) teaches a golf cart cover for clubs.
- Brock (US-6227603) teaches a golf cart cover for clubs.
- Geraud (CH-635393) teaches a frame groove that receives a bead at the edge of a canopy (FIG. 6).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is 571-272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo, can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tamara L. Graysay
Examiner
Art Unit 3636

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